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OFFICE OF PETITIONS

In re Application of :
Allan et al. :
Application No. 10/624,049 : ON PETITION
Filed: July 21, 2003 :
Atty Docket No. 454313-2180.3 :

This is a decision on the "RESPONSE TO NOTICE OF OMITTED ITEMS AND PETITION TO BE AWARDED FILING DATE," filed May 26, 2004, requesting a filing date of July 21, 2003 with Figure 7A considered a part of the original application disclosure.

The application was filed on July 21, 2003. However, on April 15, 2004, the Office mailed a "Notice of Omitted Items" stating that the application had been accorded a filing date; however, Figure 7A described in the specification appeared to have been omitted.

In response, the present petition was filed requesting, in effect, that the application be amended to include the drawing of Figure 7A described in the specification. Petitioner describes Figure 7A as being inadvertently omitted. Petitioner points out that the application as filed included an incorporation by reference of a prior application containing Figure 7A. Petitioner submitted a copy of their return postcard to show that a declaration for patent was among the items submitted on filing.

The petition is **dismissed**.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawing was in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawing in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioner neither asserts that the missing drawing was deposited on July 21, 2003, nor requests the May 26, 2004 (the date the drawing was supplied) filing date.

Instead, applicants seek to rely on the incorporation by reference statement and thereby, to amend the application to include the drawing figure 7A. However, no petition under 37 CFR 1.182 is necessary for that purpose. New drawings may be entered by the primary examiner without petition so long as the new drawings contain no new matter. See MPEP § 608.02(a).

Accordingly, the petition is inappropriate and is subject to dismissal.

It is noted that the application transmittal letter identified this application as a continuation of prior application No. 08/884,514 and specifically incorporated by reference the disclosure of the prior application. MPEP 201.06(c) states that:

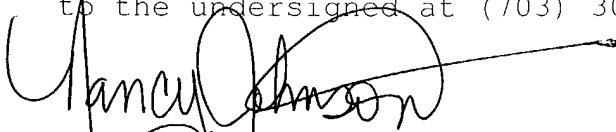
. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

(Emphasis supplied)

Obviously, in view of the incorporation by reference of the prior application, the drawing of Figure 7A is not new matter if it was a part of the disclosure of the prior application. Applicants should file a preliminary amendment requesting entry of the figure prior to the first Office action on the merits.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of July 21, 2003, including an indication in Office records that 17 sheets of drawings were present on filing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions